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PATENT

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants:	Craig A. Coburn	
Serial No.:	10/568,153	Case No.: 21504YP
US Nat'l Filing Date:	February 13, 2006	
Int'l Appl'n No.:	PCT/US2004/025791	
Int'l Filing Date:	10 August 2004	
For:	MACROCYCLIC BETA-SECRETASE INHIBITORS FOR THE TREATMENT OF ALZHEIMER'S DISEASE	

MAIL STOP 16  
 Director of the US Patent and Trademark Office  
 P. O. Box 1450  
 Alexandria, VA 22313-1450

REQUEST FOR REFUND

Sir:

Applicants respectfully request a refund of \$300.00 for the national phase entry fee for the above-referenced U.S. national phase application. The national phase entry, filed February 13, 2006, was assessed a \$600.00 filing fee to Applicant's Attorney Deposit Account No. 13-2755. The application should have been assessed a \$300.00 filing fee, based on the status of the application during the International phase as reflected on items 22 (examination fee) and 23 (search fee) of the Transmittal Letter to the United States Designated Office/Elected Office. The Written Opinion was prepared by ISA/US, and the Written Opinion indicated that all claims satisfied the provisions of PCT Article 33 (1)-(4). A copy of the Written Opinion is enclosed. As a result, there should be no charge under items 22 and 23. Accordingly, the total national phase entry fee should be \$300.00.

The PTO is requested to refund the excess amount charged (\$300.00) to the Attorney Deposit

Adjustment Account No. 13-2755  
 date: 01/18/2007 FSHITH  
 11/07/2006 FSHITH 00000001 132755 10568153  
 01 FC:1641 100.00 CR  
 02 FC:1633 200.00 CR

Favorable action is earnestly solicited.

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450, on the date appearing below.

By MERCK & CO., INC. Date 12-11-2006

Date: December 11, 2006  
 Enclosure

Respectfully submitted,

By

John C. Todaro  
 John C. Todaro, Reg. No. 36,036  
 Attorney for Applicants

MERCK & CO., Inc.  
 P.O. Box 2000  
 Rahway, New Jersey 07065  
 Tel.: (732) 594-0125

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# PATENT COOPERATION TREATY

From the  
INTERNATIONAL SEARCHING AUTHORITY

To:  
MERCK & CO., INC.  
126 EAST LINCOLN AVENUE  
RAHWAY, NJ 07065-0907

## PCT

WRITTEN OPINION OF THE  
INTERNATIONAL SEARCHING AUTHORITY

(PCT Rule 43bis.1)

Date of mailing  
(day/month/year) **16 FEB 2005**

**FOR FURTHER ACTION**  
See paragraph 2 below

Applicant's or agent's file reference

PCT 21504Y

International application No.

International filing date (day/month/year)

Priority date (day/month/year)

PCT/US04/25791

10 August 2004 (10.08.2004)

14 August 2003 (14.08.2003)

International Patent Classification (IPC) or both national classification and IPC

IPC(7): C07D 267/22, 225/04; A61K 31/33; A61P 25/28 and US Cl.: 514/183; 540/456, 461

Applicant

MERCK & CO., INC

1. This opinion contains indications relating to the following items:

- ☒ Box No. I Basis of the opinion
- ☐ Box No. II Priority
- ☐ Box No. III Non-establishment of opinion with regard to novelty, inventive step and industrial applicability
- ☐ Box No. IV Lack of unity of invention
- ☒ Box No. V Reasoned statement under Rule 43bis.1(a)(i) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement
- ☐ Box No. VI Certain documents cited
- ☐ Box No. VII Certain defects in the international application
- ☐ Box No. VIII Certain observations on the international application

### 2. FURTHER ACTION

If a demand for international preliminary examination is made, this opinion will be considered to be a written opinion of the International Preliminary Examining Authority ("IPEA") except that this does not apply where the applicant chooses an Authority other than this one to be the IPEA and the chosen IPEA has notified the International Bureau under Rule 66.1bis(b) that written opinions of this International Searching Authority will not be so considered.

If this opinion is, as provided above, considered to be a written opinion of the IPEA, the applicant is invited to submit to the IPEA a written reply together, where appropriate, with amendments, before the expiration of 3 months from the date of mailing of Form PCT/ISA/220 or before the expiration of 22 months from the priority date, whichever expires later.

For further options, see Form PCT/ISA/220.

3. For further details, see notes to Form PCT/ISA/220.

Name and mailing address of the ISA/ US

Mail Stop PCT, Attn: ISA/US  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, Virginia 22313-1450

Facsimile No. (703)305-3230

Authorized officer

Bruck Kifle, Ph.D.

Telephone No. 703-308-1235

Form PCT/ISA/237 (cover sheet) (January 2004)

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**WRITTEN OPINION OF THE  
INTERNATIONAL SEARCHING AUTHORITY**

International application No.

PCT/US04/25791

**Box No. 1 Basis of this opinion**

1. With regard to the language, this opinion has been established on the basis of the international application in the language in which it was filed, unless otherwise indicated under this item.

- ☐ This opinion has been established on the basis of a translation from the original language into the following language \_\_\_\_\_, which is the language of a translation furnished for the purposes of international search (under Rules 12.3 and 23.1(b)).

2. With regard to any nucleotide and/or amino acid sequence disclosed in the international application and necessary to the claimed invention, this opinion has been established on the basis of:

a. type of material

☐ a sequence listing

☐ table(s) related to the sequence listing

b. format of material

☐ in written format

☐ in computer readable form

c. time of filing/furnishing

☐ contained in international application as filed.

☐ filed together with the international application in computer readable form.

☐ furnished subsequently to this Authority for the purposes of search.

3. ☐ In addition, in the case that more than one version or copy of a sequence listing and/or table relating thereto has been filed or furnished, the required statements that the information in the subsequent or additional copies is identical to that in the application as filed or does not go beyond the application as filed, as appropriate, were furnished.

4. Additional comments:

WRITTEN OPINION OF THE  
INTERNATIONAL SEARCHING AUTHORITY

International application No.  
PCT/US04/25791

Box No. V Reasoned statement under Rule 43 bis.1(a)(i) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement

1. Statement

Novelty (N)

Claims 1-17 YES  
Claims NO

Inventive step (IS)

Claims 1-17 YES  
Claims NO

Industrial applicability (IA)

Claims 1-17 YES  
Claims NO

2. Citations and explanations:

Claims 1-17 meet the criteria set out in PCT Article 33(2)-(3), because the prior art does not teach or fairly suggest the claimed compounds.

Claims 1-17 meet the criteria set out in PCT Article 33(4), and thus have industrial applicability because the subject matter claimed can be made or used in industry.